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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,278	10/22/2004	Doron Lancet	28364	6650

7590

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Martin Moynihan
Anthony Castorina
Suite 207
2001 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

MYERS, CARLA J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,278

Applicant(s)

LANCET ET AL.

Examiner

Carla Myers

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-22 and 31-33 (in part), drawn to oligonucleotides, kits and arrays comprising a nucleic acid having a sequence suitable for identifying an olfactory receptor gene or variant thereof.

Group II, claims 23-30 (in part), drawn to methods for typing a subject for the presence of an allelic variant of an olfactory receptor gene.

2. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

A 371 case is considered to have unity of invention only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. In the instant application, the different inventions are linked by the technical feature of a nucleic acid encoding an olfactory receptor gene. However, nucleic acids encoding olfactory receptors were known in the art at the time the invention was made. For example, Whitaker (Accession No.

Art Unit: 1634

NM_013941; cited in the IDS) discloses a nucleic acid sequence encoding an olfactory receptor and in particular discloses a polynucleotide comprising a sequence of present SEQ ID NO: 79. Since the technical feature linking the claimed inventions was known in the art at the time the invention was made, there is no special technical feature linking the recited groups, as would be necessary to fulfill the requirement for unity of invention.

Further Election Requirement Applicable to Groups I and II

3. In addition, inventions I and II detailed above read on patentably distinct inventions drawn to oligonucleotides for detecting a olfactory receptor gene selected from SEQ ID NO: 79-104, and particularly wherein the oligonucleotide is selected from the group consisting of SEQ ID NO: 1-78.

According to PCT Rule 13.2 and to the guidelines in Section (f)(i)(A) of Annex B of the PCT Administrative Instructions, all alternatives of a Markush Group must have a common property or activity. Although the chemical compounds share a common structure in that they are nucleic acids and proteins, the compounds are not regarded as being of a similar nature because all of the alternatives do not share a common property or activity. Each of the recited oligonucleotides consists of a distinct nucleotide sequence, has a distinct melting temperature and specificity of hybridization and encodes for a protein having a distinct biological activity. Further, a search for each of these distinct inventions is not co-extensive with another. For instance, a search for SEQ ID NO: 1 is not co-extensive with a search for SEQ ID NO: 78. Further, a reference rendering an oligonucleotide consisting of SEQ ID NO: 1, for example, as anticipated or obvious over the prior art would not necessarily also render an oligonucleotide

Art Unit: 1634

consisting of SEQ ID NO: 78 as anticipated or obvious over the prior art. Similarly, a finding that an oligonucleotide consisting of SEQ ID NO: 78 was novel or unobvious over the prior art would not necessarily extend to a finding that an oligonucleotide consisting of SEQ ID NO: 78 was also novel or unobvious over the prior art.

In response to the restriction requirement, Applicant must further a sequence for identifying an olfactory receptor gene selected from the group consisting of SEQ ID NO: 79-104 or a combination of said sequences and must further elect a corresponding oligonucleotide selected from SEQ ID NO: 1-78 or a combination of oligonucleotides.

It is noted that this is a restriction requirement and should **not** be construed as an election of species.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

Art Unit: 1634

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (571) 272-0747. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach

Art Unit: 1634

the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)-272-0735.

The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).

Carla Myers
Art Unit 1634


CARLA J. MYERS
PRIMARY EXAMINER